

REMARKS

Claims 1-6, 9-12, 14, 16-23 and 25-27 are pending in the present application. Claims 1, 6, 14, 18, 23 and 25-27 have been amended, and Claims 7 and 8 have been cancelled, herewith. Reconsideration of the claims is respectfully requested.

I. 35 U.S.C. § 103, Obviousness

The Examiner rejected Claims 1-5, 7-12, 23 and 26-27 under 35 U.S.C. § 103 as being unpatentable over Patent No.: US 6,457,026 B1 issued to Graham et al. (hereinafter Graham) in view of Patent No.: US 5,664,207 issued to Crumpler et al. (hereinafter Crumpler). This rejection is respectfully traversed.

With respect to Claim 1, such claim recites (i) receiving a user input selecting the text from the electronic book to form selected text; and (ii) automatically sending the selected text to each electronic book for a designated set of recipients in response to receiving the user input selecting the text. As can be seen, the text from the electronic book that is selected by received user input is (1) automatically sent to each electronic book for a designated set of recipients, and (2) this automatic sending of selected text is done in response to receiving the user input selecting such text. These claimed features provide a highly automated environment for sharing selected text amongst a plurality of electronic books, thereby advantageously facilitating group collaboration of information using electronic books (Applicants have also amended Claim 1 to further emphasize such advantage).

In rejecting Claim 1, the Examiner states that Graham teaches

‘automatically sending the selected to each electronic document (fig. 8, the selected is automatically send (sic) to another user on the system; abstract, col. 6, lines 60-67 and col. 7, lines 1-5)’.

Applicants urge that, to the contrary, the cited Graham reference *does not teach or suggest any sending step*, either automatically or otherwise. Still further, the cited Graham reference does not teach or otherwise suggest sending *selected text*, either automatically or otherwise. Yet further, the cited Graham reference does not teach/suggest sending selected text to *each electronic book*. Thus, the Examiner’s characterizations of the Graham teachings are erroneous for at least these

three reasons. For example, Graham's Figure 8, which is cited as teaching the claimed sending step, is merely a user interface where a user can *define an annotation profile for a user or group*. This annotation profile definition does not teach any type of sending step. For example, there are no fields defined in such profile definition of who/where to send something to. Rather, the profile allows for defining characteristics of the automated annotation system, where a document can be automatically annotated (col. 7, lines 1-3). Automatically *annotating* a document does not teach or suggest automated *sending* of selected portions of a document. This can also be seen by the cited Graham abstract, where it states:

"An automated annotator is provided which finds concepts of interest and keywords. The operation of the annotator is personalizable for a particular user".

This description of finding concepts of interest, where such concepts are personalizable for a given user, does not teach or otherwise suggest an automated *sending* of selected portions to other electronic books, as expressly recited in Claim 1. Nor does the cited Graham passage at cols. 6-7 overcome this teaching deficiency. This cited passage describes the use of the profile generation capabilities shown in Figure 8, and again merely describes an ability to customize how a given document is to be annotated for a given user or group. Quite simply, customizing how a given document is *annotated* for a given user or group does not teach or otherwise suggest *sending* selected text (either (1) to (one or more) electronic books, as claimed or (2) in response to receiving the user input selecting the text, as claimed). Thus, a prima facie case of obviousness has not been established with respect to Claim 1 as there are missing claimed elements not taught or suggested by the cited references.

Still further with respect to Claim 1, it is urged that none of the cited references teach or suggest the claimed feature that the selected text is automatically sent *to each electronic book for a designated set of recipients in response to receiving the user input selecting the text*. The Examiner acknowledges that the teachings of the cited Graham reference are deficient in this regard, but cites Crumpler's teaching at Fig. 6A, items 606 and 608, col. 3, lines 28-62; col. 4, lines 38-56 and col. 9, lines 32-40 as teaching this missing claimed feature. Applicants urge that the cited Fig 6A of Crumpler describes two things – first, a determination is made as to whether there exists a user defined distribution list (block 606), and if so, this user defined distribution list

is assigned as an instance of the distribution list (block 608). In other words, this Figure 6A cited passage is directed to assigning a distribution list, and does not teach or otherwise suggest sending anything (either the selected text, as claimed, or anything else) to each electronic book for a designated set of recipients (either in response to receiving the user input selecting the text, as claimed, or otherwise). Nor does the cited Crumpler passage at cols. 3-4 overcome such teaching/suggestion deficiency. There, Crumpler describes that an entire form is sent to recipient's in-box (col. 3, lines 35-36) in response to receipt of an instance of the form (col. 3, lines 29-30). This is different from the features of Claim 1 for numerous reasons. First, the entire form is sent, *and not selected portions of text selected by user input, as claimed*. Secondly, this information is sent in response to being received by a node, *and not in response to receiving user input selecting the text, as claimed*.

As to the cited Crumpler passage at col. 9, such passage merely describes the operations previously discussed above with respect to the cited Fig. 6A blocks 606 and 608.

Thus, these cited Crumpler passages do not overcome the Graham teaching deficiencies identified above, and there are still numerous missing claimed features not taught or suggested by the cited references. Thus, Claim 1 is shown to not be obvious in view of the cited references, as there are numerous claimed features not taught or suggested by any of the cited references.

Applicants traverse the rejection of Claims 2-5 and 9-12 for reasons given above with respect to Claim 1 (of which Claims 2-5 and 7-12 depend upon). Claims 7 and 8 have been cancelled herewith, without prejudice or disclaimer.

Applicants traverse the rejection of Claims 23, 26 and 27 for similar reasons to those given above with respect to Claim 1.

Therefore, the rejection of Claims 1-5, 7-12, 23 and 26-27 under 35 U.S.C. § 103 has been overcome.

II. 35 U.S.C. § 103, Obviousness

The Examiner rejected Claim 6 under 35 U.S.C. § 103 as being unpatentable over Patent No. US 6,457,026 B1 issued to Graham et al. (hereinafter Graham) in view of Patent No. US 5,664,207 issued to Crumpler et al. (hereinafter Crumpler) and further in view of Pub. No. US

2003/0206189 A1 of DeMello et al. (hereinafter DeMello). This rejection is respectfully traversed for reasons given above with respect to independent Claim 1 (of which Claim 6 depends upon).

Therefore, the rejection of Claim 6 under 35 U.S.C. § 103 has been overcome.

III. 35 U.S.C. § 103, Obviousness

The Examiner rejected Claims 14, 16-22 and 25 under 35 U.S.C. § 103 as being unpatentable over Patent No. US 6,457,026 B1 issued to Graham et al. (hereinafter Graham) in view of Pub. No. US 2004/0199529 A1 of Clark et al. (hereinafter Clark). This rejection is respectfully traversed.

With respect to Claim 14, such claim recites “receiving selected text *from at least one remote electronic book through a communications link* to the data processing system”. As can be seen, selected text is received *from a remote electronic book* through a communication link. None of the cited references teach or suggest receiving selected text from a remote electronic book, nor has the Examiner alleged any teaching/suggestion of receiving anything (the selected text, or otherwise) *from a remote electronic book*. Rather, the Examiner alleges in rejecting Claim 14 that Graham teaches ‘receiving a first user input selecting the text from the electronic book’. Applicants urge that such assertion is with respect to a user’s manipulation to select text from an electronic book, and is not with respect to actually receiving anything from a *remote electronic book*. Thus, as none of the cited references teach or suggest the claimed step of, nor has the Examiner alleged a teaching or suggestion of, “receiving selected text *from at least one remote electronic book through a communications link* to the data processing system”, a prima facie case of obviousness has not been established with respect to Claim 14¹. Accordingly, the burden has not shifted to Appellants to rebut such improper obviousness assertion². In addition, as a proper prima facie showing of obviousness has not been established, Claim 14 has been erroneously rejected³. In any event, Applicants have amended Claim 14 to further emphasize

¹ In rejecting claims under 35 U.S.C. Section 103, the examiner bears the initial burden of presenting a prima facie case of obviousness. *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). To establish prima facie obviousness of a claimed invention, all of the claim limitations must be taught or suggested by the prior art. MPEP 2143.03. See also, *In re Royka*, 490 F.2d 580 (C.C.P.A. 1974).

² Only if that burden is met, does the burden of coming forward with evidence or argument shift to the applicant. *In re Oetiker, supra*.

³ If the examiner fails to establish a prima facie case, the rejection is improper and will be overturned. *In re Fine*,

how the present invention is substantially different from the teachings of the cited references, including the corresponding linkage between certain text of the electronic book and the remote electronic book – thereby advantageously providing ease of text collaboration between users of their respective electronic books.

Applicants initially traverse the rejection of Claims 16-22 for reasons given above with respect to Claim 14 (of which Claims 16-22 depend upon).

Further with respect to Claim 17, it is urged that none of the cited references teach or suggest the claimed feature of “wherein the selection criteria includes at least one of popularity, name of a user originating text within the selected text, and subject matter of portions of text within the selected text”. As can be seen, the specified selection criteria is one of (i) popularity, (ii) name of a user originating text within the selected text, or (iii) subject matter of portions of text within the selected text. In rejecting Claim 17, the Examiner states that the cited Clarke reference teaches ‘a set of search criteria’. Applicants urge that such general assertion with respect to ‘search criteria’ does not establish any specific teaching or suggestion with respect to the specifically enumerated list of selection criteria expressly recited in Claim 17, and thus this general allegation with respect to Clarke’s teachings of ‘a set of search criteria’ does not establish any teaching or suggestion of the specific features expressly recited in Claim 17. Accordingly, a prima facie case of obviousness has not been established with respect to Claim 17.

Further with respect to Claim 18, it is urged that none of the cited passages teach or suggest the claimed feature of “wherein the selected text includes passages from the at least one remote electronic book”. In rejecting this aspect of Claim 18, the Examiner merely alleges that the cited Graham reference teaches ‘wherein the selected text includes passages from at least one remote electronic book (user over the Internet (col. 4, lines 45-67)’. Applicants respectfully submit that a ‘user over the Internet’ does not establish any teaching/suggestion with respect to a *remote electronic book*, as expressly recited in Claim 18. Rather, this passage describes a user accessing a document through a document browser and an annotation agent (col. 4, lines 51-53). There is no mention that this document is received from, or is a part of, a *remote electronic book*, as expressly recited in Claim 18. Accordingly, a prima facie case of obviousness has not been established with respect to Claim 18.

837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988).

Further with respect to Claim 21, it is urged that none of the cited references teach or suggest the claimed feature of "wherein the selection criteria is received with the selected text". As can be seen, and when read in conjunction with independent Claim 14 (of which Claim 21 depends upon), the selection criteria that is used to sort the received selected text *is itself also received along with such selected text*. In rejecting Claim 21, the Examiner states that this claimed feature is taught by Graham's Fig. 2A. Applicants urge that Graham's Fig. 2A describes a static screen shot, and does not teach any type of receiving operation, or the receiving of selection criteria (that is used for sorting selected text) along with the selected text. Accordingly, a prima facie case of obviousness has not been established with respect to Claim 21.

Applicants traverse the rejection of Claim 25 for similar reasons to those given above with respect to Claim 14.

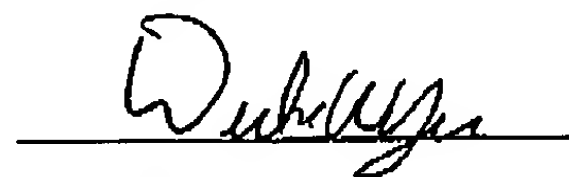
Therefore, the rejection of Claims 14, 16-22 and 25 under 35 U.S.C. § 103 has been overcome.

IV. Conclusion

It is respectfully urged that the subject application is patentable over the cited references and is now in condition for allowance. The Examiner is invited to call the undersigned at the below-listed telephone number if in the opinion of the Examiner such a telephone conference would expedite or aid the prosecution and examination of this application.

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Respectfully submitted,



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